PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Israel RUBINSTEIN, et al
Serial No.: 09/922,220 Group No.: 1797
Filed: August 3, 2001 Examiner: Lyle Alexander
For: METHOD AND APPARATUS FOR DETECTING AND QUANTIFYING A CHEMICAL SUBSTANCE EMPLOYING AN OPTICAL TRANSMISSION PROPERTY OF METALLIC ISLANDS ON A TRANSPARENT SUBSTRATE

Attorney Docket No.: U 013579-0

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO OFFICIAL ACTION

The Official Action of 14 April 2008 has been carefully considered and reconsideration of the application in view of the present submission is respectfully requested.

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Certain claims have been rejected under 35 USC 102(b) as allegedly being anticipated by Bowen et al. Other claims have been rejected under 35 USC 103(a) as allegedly being unpatentable over Bowen et al or over Bowen et al in view of Shibata et al. Applicants respectfully traverse these rejections.

The invention defined by the method claims of record (claim 213 and the claims depending therefrom) is directed to a method for analysis of a sample that requires (a) a first measurement that comprises "transmitting **electromagnetic radiation** being emitted by a transmitter through a first structure. . ." and "receiving a transmission of **said electromagnetic radiation** by a detector. . ." to generate the first measurement; and (b) a second measurement that comprises "transmitting **electromagnetic radiation** being emitted by said transmitter through said second structure. . ." and "receiving transmission of **said electromagnetic radiation** by a detector. . . ." In other words, the method claims require that the transmitted electromagnetic radiation is the radiation that is measured for the first and second measurements.

Similarly, the invention defined by the apparatus claims of record (claim 263 and the claims depending therefrom) requires the claimed apparatus to measure the electromagnetic radiation that is transmitted by a transmitter: "a transmitter comprising a generator of electromagnetic energy, a first structure. . ., and a detector configured to receive **said electromagnetic radiation being emitted by said transmitter** and transmitted through the structure".

To meet these limitations, the Examiner has referred to specific parts of the description in Bowen et al and noted the following: *"Column 9, lines 33-41 teach use of Raman standards to ensure calibration which has been read on the claimed first structure and first measurement..."* and further that *"Column 9-10, lines 60-38 respectively teach the analyte is absorbed or associated with the metal sol particles which has been read on second measurement"*. However, as next discussed, the Examiner's interpretation of the reference is respectfully incorrect: Bowen et al do not teach either the recited first measurement or the recited second measurement of claim 213 or the apparatus of claim 263.

With respect to claim 213, Bowen et al do not show or suggest making a first or second measurement by measuring the electromagnetic radiation emitted by a transmitter and transmitted through the claimed respective first and second structures. Rather, the Bowen et al, reference describes receiving a **Raman** signal by a detector. It should be understood that such a signal is of a frequency **different** from the frequency of an excitation radiation (because it is **Raman** signal). Hence, the Bowen et al reference anticipates neither the claimed first measurement (transmission of electromagnetic radiation through a first structure) nor the claimed second measurement (transmission of the electromagnetic eradiation through second structure), as claimed in Claim 213.

With respect to claim 263, Bowen et al do not describe "a detector configured to receive **said electromagnetic radiation** being emitted by **said** transmitter and transmitted through the structure". Rather, the Bowen technique uses a detector

configured to receive a **Raman** signal, i.e. signal emitted within a sample and being of a different frequency, and not **transmitted** through the structure. Hence, laser and detector (for radiation of different frequency) of the Bowen et al technique do not match the same way as the transmitter and detector of Claim 263.

In view of the above, Bowen et al cannot be considered to anticipate any of the claims of record. Moreover, since the rejections under 35 USC 103(a) are based on an incorrect interpretation of Bowen et al (see discussion above), Bowen et al also cannot be considered to set forth even a *prima facie* case of obviousness for the invention as defined by the claims of record. In this connection, there could have been no motivation or reason to modify the invention described in Bowen et al to detect something other than the Raman signals described therein since such modification would impermissibly change the principle of operation of the Bowen et al apparatus. See MPEP 2143.01(VI) ("If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.").

In view of the above, Applicants respectfully submit that all rejections and objections of record have been overcome and that the application is now in allowable form. An early notice of allowance is earnestly solicited and is believed to be fully warranted.

Respectfully submitted,

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